

REMARKS

Claims 1-40 are pending and at issue in this application. By this amendment, claims 1, 19, and 30 have been amended. No new claims have been added.

I. REJECTIONS UNDER 35 U.S.C. §101

Applicants respectfully traverse the rejection of Claims 1-10 and 19-40 as directed to non-statutory subject matter. Specifically, the Office action alleges that claims 1, 19, and 30 are not in the technical arts and are not useful because “one can do the calculation of the intensity factor to a ‘visitable site’ with paper and pen.”¹ The Office action expands on this allegation by stating that “the calculation can be done by paper and pen and thus is not in the technological arts.”²

Patentable subject matter under 35 U.S.C. §101 has been interpreted to include the transformation of data through a series of mathematical calculations to produce “a useful, concrete and tangible result.” See *In re Alappat*, 33 F. 3d 1526, 1544 (Fed. Cir. 1994). In addition, the technical arts are not limited by the ability of a person of ordinary skill in the art to simply perform manual calculations to produce the useful result, rather “the dispositive inquiry is whether the claim *as a whole* is directed towards statutory subject matter.” See *Diamond v. Diehr*, 450 U.S. 175, 187 (1981) (emphasis added). Thus, while a mathematic formula does not, on its own, constitute patentable subject matter, a mathematic formula that produces a new, non-obvious, and useful result, even if the result is expressed as a number, is patentable. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1375 (Fed. Cir. 1998).

¹ See Office action page 2, paragraph 3, lines 3-4.

² See Office action page 2, paragraph 3, lines 5-6.

Amended claims 1, 19 and 30 recite, *inter alia*, a method and system for evaluating the visits and/or popularity of a visitable site by calculating an inbound traffic intensity factor and determining the quality and intensity of said visits to the visitable site based on the inbound traffic intensity factor.³ The method and apparatus provide a "tool for measuring the intensity of the incoming traffic to a visitable site, such as an Internet web site, because the method [and apparatus] generate[] a meaningful index or number [...] reflecting both the intensity and the quality of inbound viewer and visitor traffic."⁴ The tool can, in turn, help advertisers determine the value of different types of advertising mediums such as, for example, Internet or e-commerce visitable sites, broadcast communications and printed publications. For these reasons, applicants submit that amended claims 1, 19, and 35 recite patentable subject matter within the meaning of 35 U.S.C. § 101, and respectfully request that the pending rejection be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. § 112

Applicants respectfully traverse the rejection of Claims 1-40 as indefinite for failing to clearly define the meaning of the phrases "meaningful visits" and "visitable site". In particular, the phrase "meaningful visits" is clearly defined in the specification and may be thought of, for example, as visits, which could be inbound viewer and visitor traffic, which exhibit a desired intensity and quality.⁵ "Meaningful visits" may be distinguished from "simply measuring the total number of hits or visits to a particular visitable site [with a counter, because the counter does] not differentiate between longer more meaningful stays, and very short accidental or otherwise

³ Support for these amendments may be found in the Specification at least at page 3, line 23 to page 4 line 3, and page 4, lines 4-8.

⁴ See Specification at page 4, lines 4-8.

⁵ See Specification at page 4, lines 4-8.

unmeaningful visits.”⁶ For these reasons, applicants submit that the meaning of “meaningful visits” is definite and well defined in the specification.

Similarly, applicants submit that the phrase “visitable sites” is thoroughly defined in the specification. In particular, the phrase “‘visitable sites’ is a broad term intended to include Internet or e-commerce visitable sites, like websites, as well as non-visitable sites. Examples of non-visitable sites include broadcast communications such as television, radio, cable, or satellite broadcasts or transmissions and the like. Visitable sites may also include a wide variety of periodicals and other publications including magazines, trade journals, books or other publications. The term also encompasses advertisements appearing in print, on radio or television, or Internet media, as well as a variety of public exhibitions including trade shows, professional meetings, conventions and seminars, museums, art galleries, planetariums, oceanariums, aquariums, botanical gardens and other enterprises open to the public. The term visitable site also can include certain retail establishments interested in monitoring traffic through their facility. Visitable web sites can include Internet web sites, chat rooms, news groups, search engines, as well as other Internet and/or intranet sites and other on-line sites and services.”⁷ In other words, “visitable sites” may include virtually any advertising or service for which a visitor may access and an advertiser or retailer may desire to evaluate. For these reasons, applicants submit that the meaning of “visitable site” is definite and well defined in the specification.

For the foregoing reasons, reconsideration and withdrawal of these rejection is hereby respectfully requested.

⁶ See Specification at page 3, lines 11-14.

⁷ See Specification at page 5, line 14 to page 6, line 5.

III. REJECTIONS UNDER 35 U.S.C. §103(a)

Applicants traverse the rejection of Claims 1-40 as obvious in light of U.S. Patent No. 6,651,098 (hereinafter "Carroll et al.") Amended independent claims 1, 19 and 30 recite, *inter alia*, a method and system for evaluating the visits and/or popularity of a visitable site by calculating an inbound traffic intensity factor and determining the quality and intensity of said visits to the visitable site based on the inbound traffic intensity factor. Independent claims 11 and 14 recite, *inter alia*, a method for determining trends and ranking visitable sites including calculating an inbound traffic intensity factor, respectively.

Carroll et al. does not suggest or disclose calculating an inbound traffic intensity factor (ITIF) of any kind, much less an ITIF that incorporates the incremental units of time associated with each visit and a power factor. Carroll et al. simply discloses a counter to record the number of hits occurring during a given time period without any consideration for the duration of each visit. Thus, Carroll et al. does not suggest or disclose that the time associated with each visit recorded by the hit counter could be evaluated to determine the popularity of the visitable site. Moreover, since Carroll et al. does not recognize the possibility of associating a time with each visit, the possibility of incorporating a power factor to modify the undisclosed time is completely neglected.

Because Carroll et al. does not disclose or suggest incorporating the associated time and the power factor, the counter simply provides an absolute number of visits without evaluating the intensity and quality of the visits. Further, because there is no suggestion or motivation that including this information would be desirable, or even possible, the pending action does not set forth a *prima facie* case of obviousness⁸. For

⁸ To establish a *prima facie* case of obviousness, three basic criteria must be met:

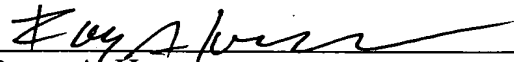
all of these reasons, applicants respectfully submit that the pending claims 1-40 are not rendered obvious by Carroll et al.

IV. CONCLUSION

For these foregoing reasons, applicant submits the application is in condition for allowance. If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections is therefore respectfully requested.

Respectfully submitted for,

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(a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

(b) Second, there must be a reasonable expectation of success.

(c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.